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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,634	06/25/2001	Gene L. Panter	79-01-001 (014208.1415)	2856

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06/21/2005

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EXAMINER

THAI, CANG G

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/891,634	PANTER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cang G. Thai	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on June 25, 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/15/2001</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 06/25/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 1 is directed to "a method for program management comprising:

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determining governance structure for a program, the governance structure providing leadership for the program and including at least one member;

applying, by at least one member of the governance structure, at least one program management discipline to the program;

applying, least one member of the governance structure, knowledge management to the program; and

applying, by at least one member of the governance structure, at least one project management methodology to at least one project associated with the program”.

In the present case, Claim 1 does not require any technology. The recited steps of program management does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea for program management.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what is the scope of the claimed invention and how the steps are implemented to achieve the scope of the claimed invention? Is it enhancing business development approach or maximizing the company market evaluation or launching a business. Applicant is recommended to insert an objective of the claimed invention in the preamble to improve clarity. Program management is not a proper scope of the claimed invention. It is not clear on the project management in the body of the claim and how it is related to the program management as mentioned in the preamble. It is also not clear on step (a), step (b), and step (c). It appears that they should be related, but no positive language showing the relationship has been shown.

Claim 36 is vague on the term "resource". Additional clarification is needed to determine the resource associated with the program.

Claim 37 is vague on the term "a human". There is no patentable weight due to applicant trying to claim a human for the invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,154,731 (MONKS ET AL).

As for Claim 1, MONKS discloses a method for program management comprising:

determining governance structure for a program, the governance structure providing leadership for the program and including at least one member {See Fig. 1, Element 2};

applying, by at least one member of the governance structure, at least one program management discipline to the program {See Fig. 1, Element 4};

applying, least one member of the governance structure, knowledge management to the program {See Fig. 1, Element 5}; and

applying, by at least one member of the governance structure, at least one project management methodology to at least one project associated with the program {See Fig. 2, Element 42}.

As for Claim 2, MONKS discloses the method for program management according to Claim 1, wherein applying governance structure comprises:

determining a steering committee associated with the program {See Fig. 1, Element 2};

determining program manager associated with the program {See Fig. 2, Element 58};

determining a program office associated with the program {See Fig. 2, Element 48}; and

determining a project manager for the project {See Fig. 2, Element 60}.

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As for Claim 3, MONKS discloses the method for program management according to Claim 1, wherein the program comprises plurality of projects {Column 6, Lines 44-47, wherein this reads over “such a data processing system is used once the Hub and Spoke configuration has been established, in which the assets of two or more funds are invested in a portfolio”}.

As for Claim 4, MONKS discloses the method for program management according to Claim 1, wherein applying the program management disciplines comprises applying value management to the program {Column 1, Lines 56-60, wherein this reads over “the key advantages of the corporate form-limited liability and a vastly expanded capacity for raising capital-have led in turn to the development of a corporate culture for removed from the greater concerns of individual owners, with a resultants focus on near-term growth and profitability”}.

As for Claim 5, MONKS discloses the method for program management according to Claim 4, wherein applying value management comprises:

assessing at least one program benefit associated with the program {See Fig. 11, Element “PUBLIC OPINION”};

allocating the program benefits to the projects {See Fig. 11, Element “SHAREHOLDERS”};

determining tracking for the program benefits {See Fig. 11, Element “MANAGEMENT CENTRALIZED DECISION-MAKING”};

determining measurements for the program benefits {See Fig. 11, Element “RULE CONTROLLING”}; and

tracking a benefit status associated with the program benefits {See Fig. 11, Element "PROFIT"}.

As for Claim 6, MONKS discloses the method for program management according Claim 5, wherein the program benefit comprises a financial benefit {See Fig. 11, Element "PROFIT"}.

As for Claim 7, MONKS discloses the method for program management according to Claim 5, wherein the benefit status comprises a financial status indicator {See Fig. 12, Element "PRESISTENT VALUE"}.

As for Claim 8, MONKS discloses the method program management according Claim 5, wherein determining tracking for the program benefit comprises:

examining the program benefit {See Fig. 12, Element "PUBLIC OPINION"};

establishing a measure associated with the program benefit {See Fig. 12, Element "SHAREHOLDERS"};

establishing a baseline associated with the measure {See Fig. 12, Element "MANAGEMENT CENTRALIZED DECISION-MAKING"};

determining trigger associated with the program benefit {See Fig. 12, Element "THE PUBLICLY HELD CORPORATION"};

integrating the trigger into program plan associated with the program and a project plan associated with the project {See Fig. 12, Element "RULE CONTROLLING"};

approving the program benefit, the baseline and the measure {See Fig. 12, Element "PRESENTING VALUE"};



updating documentation associated with the program benefit {See Fig. 12, Element "PROFIT"}; and

updating a log associated with the program benefit {See Fig. 3, Element 27}.

As for Claim 9, MONKS discloses the method for program management according to Claim 5, wherein assessing the program benefit comprises:

reviewing a program charter associated with the program {See Fig. 3, Element 14};

revising sales documentation associated with the program {See Fig. 3, Element 15}; and

reviewing financial goals associated with the program and the project {See Fig. 3, Element 23}.

As for Claim 10, MONKS discloses the method for program management according Claim 9, wherein assessing the program benefit further comprises:

linking external benefits associated with the program to a strategic goal associated with a client {See Fig. 3, Element 30};

linking internal benefits associated with the program to a benefits plan {See Fig. 4, Element 101};

determining whether the program benefits expose the program to a legal liability {See Fig. 4, Element 109};

documenting achievement of the program benefit {See Fig. 4, Element 111};

determining whether the program benefits are achievable with respect to capabilities associated with the client {See Fig. 4, Element 114};

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escalating the program benefit if the program benefit is not achievable with respect to capabilities associated with the client {See Fig. 4, Element 118}; and respectively documenting each program benefit {See Fig. 4, Element 125}.

As for Claim 11, MONKS discloses the method for program management according to Claim 5, wherein allocating the program benefits the projects comprises:

determining interdependencies between the projects based on respective charters associated with the projects with respect to at least one project benefit respectively associated the projects {See Fig. 5, Element 129};

allocating the program benefits to the projects {See Fig. 5, Element 132};

reconciling gaps between the program benefits and the project benefits {See Fig. 6, Element 133};

tracking coordination between the project benefits and the program benefits {See Fig. 6, Element 134};

documenting risks associated with the project benefits {See Fig. 6, Element 136}; and

updating the program benefits based on the project benefits {See Fig. 6, Element 135}.

As for Claim 12, MONKS discloses the method for program management according to Claim 5, wherein determining measurements for the program benefits comprises:

determining financial measure associated with the program benefit {See Fig. 3, Element 14}; and

determining an operating measure associated with the program benefit {See Fig. 3, Element 15}.

As for Claim 13, MONKS discloses the method for program management according Claim 12, wherein the financial measure comprises a revenue based measurement {See Fig. 3, Element 25}.

As for Claim 14, MONKS discloses the method for program management according Claim 12, wherein the financial measure comprises an earned value analysis based measurement {See Fig. 3, Element 26}.

As for Claim 15, MONKS discloses the method for program management according Claim 12, wherein the operating measure comprises a time-to-market based measurement {See Fig. 3, Element 27}.

As for Claim 16, MONKS discloses the method for program management according to Claim 12, wherein the operating measure comprises head count based measure {See Fig. 3, Element 28}.

As for Claim 17, MONKS discloses the method for program management according to Claim 5, wherein tracking the benefit status comprises:

reviewing current documentation associated with program benefits {See Fig. 3, Element 23};

discussing concerns associated with the program benefits with an audience based on the concerns and the program benefits {See Fig. 3, Element 28}; and

generating an issue response determining that at least one of the program benefits will not be achieved {See Fig. 3, Element 30}.

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As for Claim 18, MONKS discloses a method for program value management comprising:

assessing at least one program benefit associated with a program, the program having at least one associated project {See Fig. 1, Element 2};

determining at least one program benefit associated with the program {See Fig. 1, Element 4};

allocating the program benefits to the projects {See Fig. 2, Element 42};

determining tracking of the program benefits {See Fig. 3, Element 22}; and

determining measurement of the program benefits {See Fig. 3, Element 24}.

As for Claim 19, MONKS discloses the method for program value management according to Claim 18 and further comprising:

reviewing current documentation associated with program benefits {See Fig. 4, Element 109};

discussing concerns associated with the program benefits with an audience based on the concerns and the program benefits {See Fig. 4, Element 111}; and

generating an issue response to determining that at least one of the program benefits will not be achieved {See Fig. 4, Element 115}.

As for Claim 20, MONKS discloses the method for program management according to Claim 19, wherein benefit status comprises financial status indicator {See Fig. 4, Element 106}.

As for Claim 21, MONKS discloses the method for program value management according to Claim 18, wherein the program benefit comprises a financial benefit {See Fig. 4, Element 107}.

As for Claim 22, MONKS discloses the method for program value management according to Claim 18, wherein determining tracking the program benefit comprises:

examining the program benefit {See Fig. 11, Element "PUBLIC OPINION"};

establishing a measure associated with the program benefit {See Fig. 11, Element "MANAGEMENT CENTRALIZED DECISION-MAKING"};

establishing a baseline associated with the measure {See Fig. 11, Element "RULE CONTROL"};

determining trigger associated with the program benefit {See Fig. 11, Element "EXTERNAL MAKING"};

integrating the trigger into a program plan associated with the program and a project plan associated with the project {See Fig. 5, Element 123};

approving the program benefit, the baseline and the measure {See Fig. 5, Element 124};

updating documentation associated with the program benefit {See Fig. 5, Element 125}; and

updating a log associated with the program benefit {See Fig. 5, Element 128}.

As for Claim 23, MONKS discloses the method for program value management according to Claim 18, wherein assessing the program benefit comprises:

reviewing program charter associated with the program {See Fig. 2, Element 48};

revising sales documentation associated with program {See Fig. 2, Element 56};  
and

reviewing financial goals associated with program and the project {See Fig. 2, Element 60}.

As for Claim 24, MONKS discloses the method for program value management according Claim 23, wherein assessing the program benefit further comprises:

linking external benefits associated with the program a strategic goal associated with a client {See Fig. 4, Element 101}

linking internal benefits associated with the program to a benefits plan {See Fig. 4, Element 102}

determining whether the program benefits expose the program to a legal liability {See Fig. 4, Element 106}

documenting achievement the program benefit {See Fig. 4, Element 109}

determining whether the program benefits are achievable with respect capabilities associated with the client {See Fig. 4, Element 111}

escalating the program benefit if the program benefit not achievable with respect capabilities associated with the client {See Fig. 4, Element 121}; and

respectively documenting each program benefit {See Fig. 4, Element 122}.

As for Claim 25, MONKS discloses the method for program value management according to Claim 18, wherein allocating the program benefits to the projects comprises:

determining interdependencies between the projects based on respective charters associated the projects with respect to at least one project benefit respectively associated with the projects {See Fig. 1, Element 2};

allocating the program benefits to the projects {See Fig. 1, Element 8};

reconciling gaps between the program benefits and the project benefits {See Fig. 2, Element 40};

tracking coordination between the project benefits and the program benefits {See Fig. 2, Element 58};

documenting risks associated with the project benefits {See Fig. 3, Element 11};  
and

updating the program benefits based on the project benefits {See Fig. 3, Element 22}.

As for Claim 26, MONKS discloses the method for program value management according to Claim 18, wherein determining measurement of the program benefits comprises:

determining a financial measure associated with the program benefit {See Fig. 4, Element 103}

determining an operating measure associated with the program benefit {See Fig. 4, Element 105}.

As for Claim 27, MONKS discloses the method for program value management according to Claim 23, wherein the financial measure comprises revenue-based measurement {See Fig. 4, Element 107}.

As for Claim 28, MONKS discloses the method for program value management according Claim 23, wherein the financial measure comprises an earned value analysis based measurement {See Fig. 4, Element 109}.

As for Claim 29, MONKS discloses the method for program value management according to Claim 23, wherein the operating measure comprises a time-to-market based measurement {See Fig. 4, Element 121}.

As for Claim 30, MONKS discloses the method for program value management according to Claim 23, wherein operating measure comprises a head count based measure {See Fig. 4, Element 116}. It appears a head count based measured is also meant to calculate early withdrawal penalty (IES).

As for Claim 31, MONKS discloses a system for program management comprising:

means determining governance structure for program, the governance structure providing leadership for the program and including at least one member {See Fig. 1, Element 2};

means for applying, by least one member of the governance structure, at least one program management discipline to the program {See Fig. 1, Element 6};

means for applying, by at least one member of the governance structure, knowledge management to the program {See Fig. 1, Element 7}; and

means for applying, by at least one member of the governance structure, at least one project management methodology to at least one project associated with the program {See Fig. 2, Element 58}.



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As for Claim 32, MONKS discloses a system for program value management comprising:

means for assessing at least one program benefit associated with program, the program having at least one associated project {See Fig. 3, Element 11};

means for determining at least one program benefit associated with the program {See Fig. 3, Element 14};

means for allocating the program benefits projects {See Fig. 3, Element 24};

means determining tracking the program benefits {See Fig. 3, Element 26}; and

means for determining measurement of the program benefits {See Fig. 3, Element 27}.

Claims 33-37 are rejected due to lack of structural elements. Apparatus claims must be structurally distinguishable from the prior art. {See MPEP Section 2114}.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

1) U.S. Patent No. 6,073,104 (FIELD) is cited to teach a system for invoice record management and asset-backed commercial paper program management,

2) U.S. Patent No. 6,671,692 (MARPE ET AL) is cited to teach a system for facilitating the navigation of data, and

- 3) U.S. Patent No. 5,761,674 (ITO) is cited to teach an integrated construction project information management system.

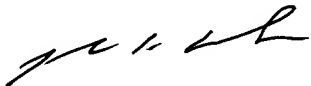
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
6/11/2005

  
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